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TECHNOLOGY CENTER 2100

In re Application of: BAHR, et al.
Application No. 09/497,383
Attorney Docket: 7204
Filed: 3 February 2000
For: SYSTEM AND METHOD FOR SCANNING
A DOCUMENT IN CLIENT/SERVER
ENVIRONMENT

**DECISION ON PETITION
UNDER 37 C.F.R. § 1.181**

This paper provides the decision on the petition, filed May 15, 2008, under 37 CFR § 1.181 to invoke Supervisory Authority with respect to the Office Communication mailed on March 14, 2008 and require the Examiner to consider Information Disclosure Statements filed on April 6, 2007, April 10, 2007, and January 11, 2008.

The Petition is **DISMISSED**.

Applicable Prosecution History

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|--------------------|--|
| April 17, 2006 | Appeal Brief filed. |
| May 16, 2006 | Examiner's answer mailed. |
| September 29, 2006 | Remand by Board to Examiner for minor corrections. |
| December 5, 2006 | Examiner's answer mailed on May 16, 2006 was vacated, and a new Examiner's Answer mailed. |
| April 6, 2007 | IDS filed. Statement under 1.97(e) missing. |
| April 10, 2007 | IDS filed. Statement under 1.97(e) missing. Exact duplicate of IDS filed on April 6, 2007. |
| January 11, 2008 | Second IDS filed. |

Decision on Petition

March 14, 2008

Office Communication mailed, informing applicant of non-consideration of the IDS for specific reasons.

May 15, 2008

Instant petition filed under MPEP 710.06, 37 CFR § 1.181 to invoke Supervisory Authority with respect to the Office Communication mailed on March 14, 2008 and require the Examiner to consider Information Disclosure Statements filed on April 6, 2007, April 10, 2007, and January 11, 2008.

August 24, 2008

Remand by Board for consideration of the Petition filed on May 15, 2008.

RELIEF REQUESTED

Petitioner requests that the Examiner of record consider the IDS filed on April 6, 2007, April 10, 2007, and January 11, 2008.

RULES, LAWS & PROCEDURES

37 CFR §1.181 Petition to the Commissioner

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the ex parte prosecution of an application *which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court*; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644. (*Emphasis added*)

37 CFR § 1.181 (f) states:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

MPEP § 609.04(b) [R-5] Timing Requirements for an Information Disclosure, states in relevant part

II. INFORMATION DISCLOSURE FILED AFTER I. ABOVE BUT BEFORE MAILING OF FINAL ACTION, NOTICE OF ALLOWANCE, OR AN EX PARTE QUAYLE ACTION (37 CFR 1.97 (c))

An information disclosure statement will be considered by the examiner if filed after the period specified in subsection I. above, but prior to the date the prosecution of the application closes, i.e., before (not on the same day as the mailing date of any of the following:

a final action under 37 CFR 1.113, e.g., final rejection;

a notice of allowance under 37 CFR 1.311; or

an action that closes prosecution in the application, e.g., an Ex parte Quayle action, whichever occurs first, provided the information disclosure statement is accompanied by either (1) a statement as specified in 37 CFR 1.97(e) (see the discussion in subsection III.B(5) below); or (2) the fee set forth in 37 CFR 1.17(p).

If a final action, notice of allowance, or an Ex parte Quayle action is mailed in an application and later withdrawn, the application will be considered as not having had a final action, notice of allowance, or an Ex parte Quayle action mailed for purposes of considering an information disclosure statement.

An Ex parte Quayle action is an action that closes the prosecution in the application as referred to in 37 CFR 1.97(c). Therefore, an information disclosure statement filed after an Ex parte Quayle action, must comply with the provisions of 37 CFR 1.97(d).

III. INFORMATION DISCLOSURE STATEMENT FILED AFTER II. ABOVE BUT PRIOR TO PAYMENT OF ISSUE FEE (37 CFR 1.97 (d))

An information disclosure statement will be considered by the examiner if filed on or after the mailing date of any of the following: a final action under 37 CFR 1.113; a notice of allowance under 37 CFR 1.311; or an action that closes prosecution in the application, e.g., an Ex parte Quayle action, but before or simultaneous with payment of the issue fee, provided the statement is accompanied by:

(A) a statement as specified in 37 CFR 1.97(e) (see the discussion in subsection V; and

(B) the fee set forth in 37 CFR 1.17(p).

These requirements are appropriate in view of the late stage of prosecution when the information is being submitted, i.e., after the examiner has reached a final determination on the patentability of the claims presented for examination. Payment of the fee (37 CFR 1.17(p)) and submission of the appropriate statement (37 CFR 1.97(e)) are the essential elements for having information considered at this advanced stage of prosecution, assuming the content requirements of 37 CFR 1.98 are satisfied.

DECISION

I. Petition for consideration of IDS

a. Petitioner's position

Applicant filed the instant petition on May 15, 2008, requesting consideration of the IDS filed on April 6, 2007, April 10, 2007, and January 11, 2008. Applicant asserts that the Information Disclosure statements included the required certification (under 37 CFR 1.97(e)(1)) (refer MPEP § 609.04(b) reproduced above) or fee (under 37 CFR 1.17(p)). Applicant, therefore, considers examiner's refusal to consider the IDS was erroneous

b. Relevant Prosecution History

A review of the prosecution history in the instant application reveals the following:

1. An examiner's answer to appeal brief filed on 4/17/2006, was mailed on May 16, 2006.
2. A Reply Brief was filed by applicant on 7/14/2006, and was entered by examiner in the communication mailed on August 28, 2006.
3. The case was remanded by the Board for minor corrections by the examiner, and a new examiner's answer was mailed out on December 5, 2006.
4. Applicant filed an IDS on April 7, and refilled the same IDS on April 10, 2007.

Specifically, the examiner refused consideration of these IDS on the grounds that:

- The IDS filed on April 7, 2007 and filed again on April 10, 2007 **did not include a statement under 37 CFR 1.97(e)** as required by MPEP § 609.04(b).
 - The fee under 37 CFR 1.17(p) were paid in both instances. However, neither contained a statement under 37 CFR 1.97(e).
5. Applicant filed a second IDS on January 11, 2008.

Specifically, the examiner refused consideration of this IDS on the grounds that:

- This IDS filed on January 11, 2008 **did not include a fee** under 37 CFR 1.17(p), (though it did contain a statement under 37 CFR 1.97(e)).

The position of the examiner regarding the above three IDS submissions were informed to the Applicant in the Office Communication mailed on March 14, 2008.

6. Applicant filed the instant petition, requesting that the IDS filed on April 6, 2007, the duplicate filed on April 10, 2007, and the IDS filed on January 11, 2008 be considered by the examiner.

b. Timeliness of the Petition

Under 37 CFR 1.181(f) (cited above) a petition for supervisory review not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. Applicant's petition was filed more than 2 months after the issuance of the Office action complained of. For this reason alone, the petitioner is not entitled to relief.

c. The instant application

Petitioner contends that the Information Disclosure statements included the required certification (under 37 CFR 1.97(e)(1)) or fee (under 37 CFR 1.17(p)).

However, it is noted that MPEP § 609.04(b) (III) (reproduced above) clearly states "**Payment of the fee (37 CFR 1.17(p)) and submission of the appropriate statement (37 CFR 1.97(e))** are the essential elements for having information considered at this advanced stage of prosecution, assuming the content requirements of 37 CFR 1.98 are satisfied".

Applicants have failed to meet one of the 2 requirements stated above in each of the IDS submissions argued above.


Accordingly, Applicant's petition, and request for consideration of the IDS filed on April 6, 2007, April 10, 2007, and January 11, 2008 is **DISMISSED**.

CONCLUSION

Petition is **DISMISSED**.

The application is being forwarded to the Board of Patent Appeals and Interferences for consideration of the Appeal.

Any inquiry concerning this decision should be directed to Kim Huynh whose telephone number is (571) 272-4147.



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| 09/497,383 | 02/03/2000 | David L. Bahr | 7204 | 7431 |

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NEURAUTER, GEORGE C

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02/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.